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PATENT
P56284

~~DAC~~
2665

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

JAI-YOUNG PARK

Serial No.: 09/756,866

Examiner: NGUYEN, STEVEN H.D.

Filed: 10 January 2001

Art Unit: 2665

For: ADD/DROP CROSS CONNECTION APPARATUS FOR SYNCHRONOUS
DIGITAL HIERARCHY

PETITION UNDER 37 CFR §1.181

The Honorable Commissioner
of Patents & Trademarks
Washington, D.C. 20231

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JUL 22 2004

Technology Center 2600

Sir:

In response to the first Office action (Paper No. 5) mailed 7 July 2004, entry and consideration of the following timely filed petition is respectfully requested.

Folio: P56284
Date: 7/19/04
I.D.: REB/kf

STATEMENT OF FACTS

1. On 7 July 2004, the Examiner mailed an Office action (Paper No. 5). In paragraph 2 of Paper No. 5, the Examiner required labeling of Figure 1 as “Prior Art”.
2. Three copies of Decisions on Petition for the following references previously issued by Group Directors to reverse similar requirements by other Examiners to label drawings as “PRIOR ART”, are enclosed:
 - Paper No. 21 issued on 25 February 1998 for U.S. Application SN. 08/447,279 filed on 22 May 1995;
 - Paper No. 15 issued on 2 October 1996 for U.S. Application SN. 08/343,939 filed on 17 November 1994; and
 - Paper No. (unknown) issued on 15 December 1999 for U.S. Application SN. 08/985,544 filed on 5 December 1997.

REMARKS

In Paper No. 5, the Examiner erroneously maintained the objection on Figure 1 to be labeled as "PRIOR ART". The Examiner states:

"Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated."

MPEP §608.02(g) states:

"Figures showing the prior art are usually unnecessary and should be cancelled, Ex parte Elliott, 1904 C.D. 103; 109 O.G. 1337. However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

If the prior art figure is not labeled, the following paragraph may be used.

Figure should be designated by a legend such as Prior Art in order to clarify what is applicant's invention. (See MPEP w 608.02(g)).

Applicant has explained that Figure 1 is not "PRIOR ART".

First, in Paper No. 5, the Office action dated 7 July 2004, the Examiner asserted that "Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated" and cited section 608.02(g) of the *Manual Patent Examining Procedure*. The term "Prior Art" is defined by statute, not by the MPEP. Specifically, 35 U.S.C. §103(a) and (b) define the term "Prior Art" by reference to the several paragraphs of 35 U.S.C. §102. Nothing in any paragraph of §102 however, states that subject matter "which is *old*" constitutes prior art, as asserted by the Examiner in page 2 of the Office action, Paper No. 5. In short, the

age of the subject matter does not convert that subject matter into prior art, as the term “prior art” is defined by the law of the United States. Consequently, the Examiner’s sole rationale for imposing the requirement that Figure 1 be labeled as “Prior Art” is contrary to statute and improper. The requirement must be therefore be withdrawn.

Second, Figure 1 is not itself believed to constitute “PRIOR ART” as that term is defined by either 35 USC §102 or 35 USC §103. The Examiner has introduced no evidence into the record of this application which would either contradict Applicant’s belief or establish that Figure 1 constituted *prior art*, as that term is defined by statute. As evidenced from the Declaration/Oath, the Applicant is a citizen of Korea, and, as such, devised Figure 1 in Korea in order to illustrate Applicant’s discovery of problems plagued in the art. Therefore, since there is no showing that Figure 1 was known to anyone other than the Applicant *in this country* nor is there a showing that Figure 1 was *patented or published in this country or a foreign country*, then Figure 1 can not be deemed to be “PRIOR ART” absent evidence to the contrary.

Third, Figure 1 is simply abstract representations of the art prepared by the Applicant in an effort to illustrate Applicant’s discovery of problems plagued in the art in accordance with 37 CFR §1.83(b); this discovery is itself, together with Applicant’s abstraction of the art represented by Figure 1, part of the Applicant’s invention. By identifying deficiencies in the prior art and then addressing those deficiencies, Applicant completes the inventive process. As such, Applicant’s effort to identify deficiencies or other undesirable features in the art, does not

constitute “Prior Art” as that term is used under 35 USC §103, and defined by 35 USC §§102(a)-(g).

Fourth, Applicant has never made any statement admitting that Figure 1 was “PRIOR ART”. If the Examiner is relying on the Applicant's use of the word “conventional” to mean “known by others in this country”, then the Examiner is incorrect. The present application is based on, and is a translation of, Korean Application Serial No. 2000-897, on which the Applicant has claimed priority as evidenced by the Declaration (Oath). Accordingly, the term “conventional” can, at most, only be considered with respect to Korea, not this country. MPEP §706.02(c) states, in part:

“The language ‘in this country’ means in the United States only and does not include other WTO or NAFTA member countries.”

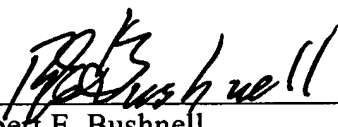
If the Examiner is relying on the Applicant's use of the word “conventional” to mean “patented or published in this country or a foreign country”, then the Examiner is again incorrect. There is no evidence that Figure 1 exists in any printed form other than in the present application and its priority document. There is evidence to indicate that Applicant devised the subject matter in Figure 1 however, and that evidence lies in the fact that the only existence of Figure 1 is in the present application and its priority document.

REMEDY REQUESTED

In view of the above, the Commissioner is respectfully requested to:

- A. Withdraw the requirement to label Figure 1 as "PRIOR ART";
- B. Grant Applicant such other and further relief as justice may require.

Respectfully submitted,



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I.D.: REB/kf

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Director's Office
Group 2700



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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Paper No. 21

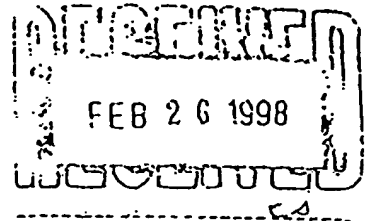


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In re Application of)	
Gwon-Il Kim)	
Application Serial No.)	
08/447,279)	
Filed: May 22, 1995)	DECISION ON RENEWED
For: SERVO CONTROLLER)	PETITION UNDER
APPARATUS AND METHOD)	37 C.F.R. § 1.181
OF DISK RECORDING)	
SYSTEM)	

This is a decision on the renewed petition filed August 25, 1997 under 37 C.F.R. § 1.181 of the repeated requirement of the Examiner to label Applicant's Figures one through three as "prior art". The petition is treated as a request for reconsideration of the previous decision of August 19, 1997 in which the requirement of labeling figures one through three as "prior art" was maintained.

A careful review of the application papers indicates that the subject matter of figures one through three is considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "prior art". "When applicant states that something is prior art, it is taken as being available as prior art against the claims. Admitted prior art can be used in obviousness rejections. In re Nomiya, 184 USPQ 607, 610 (CCPA 1975) (Figures in the application labeled "prior art" held to be an admission that what was pictured was prior art relative to applicant's invention.)" See M.P.E.P. § 2129. The decision, supra, was cited by both petitioner and the deciding official in the previous petition. Whether the subject matter of figures one through three of the instant application is prior art against the claims is an appealable determination and, accordingly, will not be entertained in this decision, see M.P.E.P. § 1201.

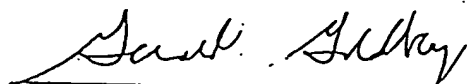
There is no requirement that a particular figure or figures be labeled as "prior art". The MPEP at section 608.02(g) indicates that if prior art figures are to be retained in the file they

should be designated with the legend of "prior art". No requirement is made for an applicant to label figure(s) as "prior art" where there is no such indication in the disclosure.

Consequently, the requirement that figures one through three each be designated by the legend of "prior art" is withdrawn.

As the time for perfecting the appeal under 37 C.F.R. § 1.192(a) has expired without the submission of an Appeal Brief, the appeal is hereby dismissed, 37 C.F.R. § 1.192(b). The application file will be forwarded to the examiner for appropriate action in due course.

SUMMARY: Petition GRANTED.

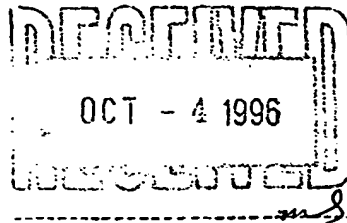


Gerald Goldberg, Director
Technology Center 2700-
Communications and Information Processing



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231



#15



Re Application of
MYUNG-CHAN JEONG
Serial No: 08/343,939
Filed on : November 17, 1994
For : DIGITAL SERVO CONTROL
APPARATUS AND METHOD
OF DATA STORAGE SYSTEM
USING DISK RECORDING
MEDIA

DECISION ON PETITION
UNDER 37 CFR 1.181

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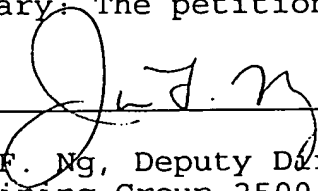
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This is a decision on the petition filed on September 13, 1996 requesting the withdrawal of the requirement to label Fig. 3 as "Prior Art".

The petition is GRANTED.

A review of the record indicates that figure 3 as originally filed and discussed was referred to as "CONVENTIONAL". Hence, in keeping with the disclosure and petitioner's arguments, the examiners' requirement to label this figure as "Prior Art" is incorrect and withdrawn.

Summary: The petition is Granted.


Jin F. Ng, Deputy Director
Examining Group 2500
Electrical and Optical Systems
and Devices

JFN/AMP

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OFFICE OF THE DIRECTOR
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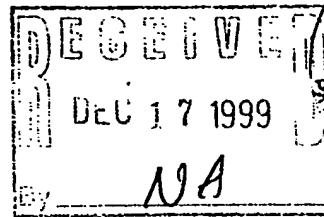
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In re application of
Hae-Won Ahn
Serial No.: 08/985,544
Filed : December 5, 1997
For: FRONT CASE STRUCTURE OF CRT
DISPLAY DEVICE

PS4947

: DECISION ON PETITION
: UNDER 37 CFR §1.181
: REQUESTING THAT
: THE COMMISSIONER
: INVOKE SUPERVISORY
: AUTHORITY

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In the renewed petition filed September 9, 1999, applicant requested that the Commissioner invoke supervisory authority by instructing the examiner to withdraw the requirement that Figs. 1 and 2 be labeled as "Prior Art". The petition is **GRANTED**.

This petition presents two issues. First, are the figures in question necessary to the understanding of the invention? A review of the application has been made and it is considered that the figures are necessary to the understanding of the invention. Second, are the figures required to be labeled with the legend "Prior Art"?

A careful review of the application papers indicates that the subject matter of Figures 1 and 2 are considered by applicant to be "conventional". However, there is no indication in the disclosure that the subject matter of the figures is expressly considered by the applicant to be "Prior Art". If applicant states that something is prior art, it is available for use against the claims. See In re Nomiya, 184 USPQ 607 (CCPA 1975), MPEP §2129. No opinion is expressed in this decision whether the subject matter of Figures 1 and 2 are "Prior Art" since this is an appealable issue, MPEP §1201.

Finally, any concerns raised in the previous decision regarding applicant's duty of disclosure are withdrawn. The Office does not normally investigate such issues.
1135 Off. Gaz. Pat. Office, 13 (Jan. 9, 1992).

This application is being forwarded to the examiner for reinstatement of Figs. 1 and 2 and deletion of the amendment after final filed August 4, 1999.

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